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THE DOW CHEMICAL COMPANY
INTELLECTUAL PROPERTY SECTION,
P. O. BOX 1967
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In re Application of	:	
Baikerikar et al.	:	
Application No.: 10/549,356	:	DECISION ON PETITION
PCT No.: PCT/US04/10330	:	
Int. Filing Date: 31 March 2004	:	UNDER 37 CFR 1.78(a)(6)
Priority Date: 02 April 2003	:	
Attorney Docket No.: 62657A	:	
For: Organosilicate Resin Formulation	:	
For Use In Microelectronic Devices	:	

This is a decision on the petition under 37 CFR § 1.78(a)(6), filed 26 February 2010, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of the prior-filed provisional application set forth in the concurrently filed amendment.

The petition is **DISMISSED AS MOOT**.

A petition under 37 CFR § 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000.

The petition was accompanied by an amendment to the first sentence of the specification following the title to include a reference to the prior-filed applications.

This nonprovisional application is the national stage of PCT/US2004/010330, which was filed on 31 March 2004, within twelve months of the filing date of the prior-filed provisional application, Application No. 60/459,730, which was filed on 02 April 2003. This application was pending at the time of filing of this petition. While a reference to the prior-filed applications was not included in an ADS or in the first sentence of the specification following the title, reference nevertheless was made in the declaration filed with the above-identified national stage entry.

The current procedure where a claim for priority under 37 CFR § 1.78(a)(6) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in

37 CFR § 1.78(a)(5)(ii). However, on the other hand, if the USPTO does not note the claim for priority to the prior-filed application(s) set forth in the oath or declaration or transmittal letter submitted with the application, a petition will be required to accept a late claim for priority under 37 CFR § 1.78(a)(6).¹ In the instant case, the Office noted the claim for priority of the prior-filed application in the declaration filed with the application, as shown by its inclusion on the filing receipt.

In view of the above, the \$1410.00 petition fee submitted is unnecessary and will be refunded to petitioner's deposit account in due course.

It is noted that the amendment filed on 26 February 2010 is not acceptable as drafted since it improperly incorporates by reference the prior-filed application. Petitioner's attention is directed to Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980), where the court drew a distinction between a permissible 35 U.S.C. § 120 statement and the impermissible introduction of new matter by way of incorporation by reference in a 35 U.S.C. § 120 statement. The court specifically stated:

Section 120 merely provides a mechanism whereby an application becomes entitled to benefit of the filing date of an earlier application disclosing the same subject matter. Common subject matter must be disclosed, in both applications, either specifically or by an express incorporation-by-reference of prior disclosed subject matter. Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. In re deSeversky, supra at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to pierce new matter barriers. It cannot, therefore, "limit" the absolute and express prohibition against new matter contained in section 251.

In order for the incorporation by reference statement to be effective as a proper safeguard against the omission of a portion of a prior application, the incorporation by reference statement must be included in the specification-as-filed, or in an amendment specifically referred to in an oath or declaration executing the application. See In re deSeversky, supra. Note also MPEP 201.06(c).

Any questions concerning this decision on petition may be directed to George Dombroske at (571) 272-3283. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This matter is being referred to the Examiner of Technology Center AU 1715 for appropriate action on the amendment filed 26 February 2010, including consideration of the claim under 35

¹ Note MPEP 201.11 (III)(D), pages 200-59 and 200-60 (Rev. 2. May 2004) and 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.

U.S.C. § 119(e) and 37 CFR 1.78(a)(5) for benefit of the prior-filed application.

/George Dombroske/.
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